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Michael B. Stewart  
Rader, Fishman & Grauer PLLC  
39533 Woodward Avenue, Suite 140  
Bloomfield Hills, MI 48304

EXAMINER
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JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/835,206	<b>Applicant(s)</b> BENNETT ET AL	
	<b>Examiner</b> Jean D Janvier	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **Response To Applicant's Amendments**

The Examiner approves the changes to the claimed invention. Further, the Examiner withdraws the 101 Rejection and the Claim Objections. Finally, the Objection to claim 3 was meant to notify the Applicant of the Examiner's interpretation of the claim and such interpretation is factually correct contrary to the Applicant's arguments.

### **DETAILED ACTION**

#### ***Specification***

The title of the invention, under 37 C.F.R 1.72, should be descriptive, brief and technically accurate.

#### ***Claim Status***

Claims 1-29 were originally presented for prosecution. After a restriction requirement, Applicant has elected with traverse to have claims 1-24 examined. Hence, claims 1-24 are herein being examined and claims 25-29 are canceled.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2-6 and 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Kamakura et al. (hereinafter Karakura), US Patent 6,076,101.

As per claim 1, Karakura discloses a system for distributing by a third party or processing or clearinghouse targeted e-mails having incorporated therein senders' or merchants' promotional messages and bonus points or electronic communications to qualified and registered recipients or patrons from registered senders or companies or merchants (recipients or participating patrons providing e-mail addresses to processing facility or clearinghouse during a registration process), wherein a registered patron is encouraged to reply to a targeted e-mail message sent from an identified merchant or company and earn bonus points. An original e-mail sent from at least one registered merchant or company via a merchant terminal is stored in an outgoing message storage unit or database coupled to a host computer or file server at a processing facility or clearinghouse. An outgoing mail registration unit (a registration database file) storing a list (a subset) of registered recipients or patrons to whom the targeted e-mail should be delivered and information regarding bonus points or electronic communications that should be credited to responding patrons, thereby inducing them to read the targeted e-mail as intended by the merchant. Further, the system or the processing facility keeps track of the number of points or bonus points accumulated by each registered and responding recipient or patron and notifies a recipient or patron when his accumulated points reach a predetermined threshold and wherein the accumulated points can be utilized to purchase a particular gift or

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product (See abstract; figs. 1-11; col. 1: 56 to col. 2: 13; col. 9: 10 to col. 10: 32; see claims 1-11 of the present reference).

**Finally, it is to be recognized here that Kamakura discloses a system, wherein a processing facility or clearinghouse originally prompted, over communication network 4 or the Internet, a recipient or user to register via a communication means, such as a web page related to a web site of server 2, by filling out an electronic application form where the recipient or user provides, among other things, his demographic information including his e-mail address and wherein the user's e-mail address is used by the clearinghouse to send targeted promotional messages from a sender or company or merchant or advertiser (See abstract; col. 1: 12-18; col. 1: 66 to col. 2: 3; col. 2: 66 to col. 3: 2; col. 3: 21-32; col. 4: 38-51).**

As per claims 2-6, 9, 10, 11 and 12, Karakura discloses a system for distributing by a third party or processing or clearinghouse targeted e-mails having incorporated therein senders' or merchants' promotional messages and bonus points or electronic communications to qualified and registered recipients or patrons from registered senders or companies or merchants (recipients or participating patrons providing e-mail addresses to processing facility or clearinghouse during a registration process), wherein a registered patron (having a unique recipient ID or account) is encouraged to reply to a targeted e-mail message sent from an identified merchant or company (having a unique merchant ID or account) and earn bonus points. An original e-mail sent from at least one registered merchant or company via a merchant terminal 1a-1b of fig. 1 is received and stored in an outgoing message storage unit or database coupled to a host computer or file server 2 of fig. 2 at a processing facility or clearinghouse. An



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outgoing mail registration unit (a registration database file) storing a list (a subset) of registered recipients or patrons to whom the targeted e-mail should be delivered (based on the patrons' profile and categories of topics) and information regarding bonus points or electronic communications that should be credited to responding patrons replying to the e-mail using terminals 3a-3b of fig. 1 connected to a communication network 4, thereby inducing them to read the targeted e-mail as intended by the merchant. In other words, targeted e-mail messages from specific registered merchants or senders are delivered to a subset or a list of registered patrons or recipients according to the patrons' profile matching the profile of the specific merchants (matching a subset of merchants with a subset of patrons based on mutual interests). Further, the system or the processing facility keeps track of the number of points or bonus points accumulated by each registered and responding recipient or patron and notifies a recipient or patron when his accumulated points reach a predetermined threshold and wherein the accumulated points can be utilized to purchase a particular gift or product (See abstract; figs. 1-11; col. 1: 56 to col. 2: 13; col. 9: 10 to col. 10: 32; col. 4: 38-51; see claims 1-11 of the present reference).

In addition, the system or processing facility monitors the patrons comments or responses to a particular e-mail so as to determine whether a patron is a first-time respondent to any e-mail communication and if the patron is a first-time respondent, then a file is created for the patron (an entry table is created), which stores the points earned by the patron for responding or replying to the e-mail. On the other hand, if the responding recipient is a regular, then the number of stored points already accumulated in his file is updated. The system also tracks the number of lines in the patron's response or reply and issues points or bonus points to the patron

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based on the number of lines included in the reply. The processing facility also allows the patron to reply to the same e-mail in more than one occasions and monitors each reply to make sure that the information printed in a subsequent or second reply is unique or different from the information associated with a previous reply to the same e-mail communication, thereby preventing fraud while rendering the system more effective (col. 7: 17 to col. 9: 9). It is further understood that the e-mail communication is sent out to the patron, on a periodic basis or during an advertising or promotional campaign conducted on behalf of the merchant or company by the processing facility or clearinghouse, based on the patron's profile.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 7-8, 13, 14-16, 17, 18 and 19-24 are rejected under 35 USC 103(a) as being unpatentable over Kamakura.

As per claims 7, 14-15, 18, 19, 20 and 22-24, Karakura discloses a system for distributing by a third party or processing or clearinghouse targeted e-mails having incorporated therein senders' or merchants' promotional messages and bonus points or electronic communications to qualified and registered recipients or patrons from registered senders or companies or merchants (recipients or participating patrons providing e-mail addresses to processing facility or clearinghouse during a registration process), wherein a registered patron (having a unique recipient ID or account or identifier or code used to reply to e-mail messages from a plurality of merchants associated with the processing facility or clearinghouse) is encouraged to reply to a targeted e-mail message sent from an identified merchant or company (having a unique merchant ID or account) and earn bonus points. An original e-mail sent from at least one registered merchant or company via a merchant terminal 1a-1b of fig. 1 is received and stored in an outgoing message storage unit or database coupled to a host computer or file server 2 of fig. 2 at a processing facility or clearinghouse (the registered merchant sends e-mail messages or data via terminal 1a-1b or physical unit to the processing facility or center on a periodic basis or during a special promotional campaign, as practiced in the industry). An outgoing mail registration unit (a registration database file) storing a list (a subset) of registered recipients or patrons to whom the targeted e-mail should be delivered (based on the patrons' profile and categories of topics) and information regarding bonus points or electronic communications that should be credited to responding patrons replying to the e-mail using terminals 3a-3b of fig. 1 connected to a



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communication network 4, thereby inducing them to read the targeted e-mail as intended by the merchant. In other words, targeted e-mail messages from specific registered merchants or senders are delivered to a subset or a list of registered patrons or recipients according to the patrons' profile matching the profile of the specific merchants (matching a subset of merchants with a subset of patrons based on mutual interests). Further, the system or the processing facility keeps track of the number of points or bonus points accumulated by each registered and responding recipient or patron and notifies a recipient or patron when his accumulated points reach a predetermined threshold and wherein the accumulated points can be utilized to purchase a particular gift or product (See abstract; figs. 1-11; col. 1: 56 to col. 2: 13; col. 9: 10 to col. 10: 32; col. 4: 38-51; see claims 1-11 of the present reference).

**Finally, it is to be recognized here that Kamakura discloses a system, wherein a processing facility or clearinghouse originally prompted, over communication network 4 or the Internet, a recipient or user to register via a communication means, such as a web page related to a web site of server 2, by filling out an electronic application form where the recipient or user provides, among other things, his demographic information including his e-mail address and wherein the user's e-mail address is used by the clearinghouse to send targeted promotional messages from a sender or company or merchant or advertiser (See abstract; col. 1: 12-18; col. 1: 66 to col. 2: 3; col. 2: 66 to col. 3: 2; col. 3: 21-32; col. 4: 38-51).**

In addition, the system or processing facility monitors the patrons comments or responses to a particular e-mail so as to determine whether a patron is a first-time respondent to any e-mail communication and if the patron is a first-time respondent, then a file is created for the patron (an entry table is created), which stores the points earned by the patron for responding or

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replying to the e-mail. On the other hand, if the responding recipient is a regular, then the number of stored points already accumulated in his file is updated. The system also tracks the number of lines in the patron's response or reply and issues points or bonus points to the patron based on the number of lines included in the reply. The processing facility also allows the patron to reply to the same e-mail in more than one occasions and monitors each reply to make sure that the information printed in a subsequent or second reply is unique or different from the information associated with a previous reply to the same e-mail communication, thereby preventing fraud while rendering the system more effective (col. 7: 17 to col. 9: 9). It is further understood that the e-mail communication is sent out to the patron, on a periodic basis or during an advertising or promotional campaign conducted on behalf of the merchant or company by the processing facility or clearinghouse, based on the patron's profile.

As per claims 8, 14, 16, 19 and 21, Kamakura does not explicitly disclose sending to a patron or recipient an e-mail or electronic communication **containing a hyperlink**, which upon activation allows the patron or the recipient of the e-mail to visit a web page (interface) corresponding to a merchant's unit or sender of the e-mail where the patron can access using an identification device or a patron's terminal 3a-3b of fig. 1 the merchant's unit or terminal 1a-1b to conduct a transaction and wherein information regarding the patron's visit at the merchant's site or web page is stored at the merchant's unit.

However, sending or transmitting a message or advertising message to a customer having printed therein a hyperlink, representative of an advertiser's web site, and upon activating or

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clicking on the hyperlink the customer can visit the advertiser's web site to obtain more information about an advertised product or a product featured in the advertising message or even purchase the advertised product or service or other products or services and wherein data regarding the transaction or the purchase are stored at the advertiser's system or web server is an old and well established in the art. For example, a business entity or associate's of an advertiser (advertising medium) will send an e-mail (or regular mail) to a customer inviting him to visit the associate's web site and receive product information regarding products of interest to the customer and wherein upon clicking on a hyperlink, displayed on the customer's computer screen while visiting the associate's web site and reading or viewing information related to a product of interest, the customer can be transported to another web site or the advertiser's web site where the customer can obtain additional or more detailed information regarding the advertised product or product of interest or even purchase the said product or other products or services and wherein data regarding the transaction or the purchase are stored at the advertiser's system or web server where they are being utilized in further marketing analysis or to further target the customer and to compile accounting report used to compensate different associates for successfully referring customers to the advertiser's web site. In another example, Freelotto.com, an Internet site offering free lotto picks to registered customers from a lottery game run and controlled by the site, will send the results of a drawing to a registered customer along with an advertising message including a hyperlink, indicative of the advertiser's web site, via e-mail and upon clicking on the hyperlink printed in the e-mail message, the customer can visit the advertiser's web site where he can receive more information regarding a product or service featured in the advertising message ("Official Notice").

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention, without reading the Instant Application, to incorporate the above disclosure (“Official Notice”) into the e-mail communication of Kamakura so as to send or transmit by a processing facility or clearinghouse an e-mail message, having printed therein an advertising message from a merchant along with a hyperlink representative of the merchant’s web site address, to a registered recipient or patron and wherein, upon clicking on the hyperlink displayed in the e-mail message, the recipient is transported to the merchant’s or advertiser’s web site where the recipient can receive more detailed information about a product or service featured in the advertising message or even purchase the said product or service or other products or services and the recipient earns bonus points for reading the e-mail and visiting the merchant’s web site and wherein data regarding the transaction or the purchase are stored at the advertiser’s system or web server where they are being utilized in further marketing analysis or to further target the customer and to compile accounting report used to compensate the processing facility or clearinghouse for successfully referring customers to the advertiser’s or merchant’s web site, thereby allowing a patron or recipient who reads a merchant’s advertising message to immediately provide feedback to the merchant or advertiser or sender of the targeted e-mail and earn bonus points when the patron clicks on a hyperlink within the e-mail to visit the merchant’s or advertiser’s web site to receive more information about a product or service featured in the e-mail or even purchase the said product or service or other products or services sold at the merchant’s web site and wherein data regarding the transaction or the purchase are stored at the advertiser’s or merchant’s system or web server where they are being utilized in further

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marketing analysis or to further target the customer and to compile accounting report used to compensate the processing facility or clearinghouse for successfully referring customers to the advertiser's or merchant's web site, while rendering the system more cost-effective and enabling the merchant to measure the effectiveness of the distribution medium or processing facility in real-time.

As per claim 7, Kamakura does not expressly disclose the steps of verifying an e-mail address provided by a patron or recipient by sending a test e-mail to the patron and saving or storing in a database of the clearinghouse the success of the test.

However, the process of sending a test e-mail to a recipient or patron to thereby verify the accuracy of the recipient's provided e-mail address is a matter of choice or desire, which does not directly or indirectly impact the utility or the functionality of the system by which a patronage e-mail is sent to the registered recipient or patron. Further, when an e-mail or test e-mail is transmitted over a network, such as the Internet, to a recipient's e-mail address, the system does not distinguish between the regular e-mail or test e-mail and if the patron's e-mail address is incorrect, then the system will return an **undeliverable mail notification message** to the originator or sender of the e-mail, regardless of the content of the sent e-mail (regular e-mail or test mail), otherwise the recipient will receive the sent or transmitted e-mail accordingly.

The latter conclusion is well within the skills of an ordinary artisan who would have been motivated at the time of the invention to test e-mail addresses provided by customers during registration at the processing facility or center by sending test or introductory e-mails to these recipients or customers and to quickly detect and dismiss recipients with undeliverable or



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inaccurate e-mail addresses, thereby guaranteeing that the merchants' or senders' or advertisers' advertising messages embedded or displayed in the e-mail messages are delivered to recipients with correct e-mail addresses, while making sure that the merchants compensate the processing facility or center for e-mail messages, including advertising the merchants' messages, that are properly delivered or transmitted to the targeted recipients with the correct and deliverable e-mail addresses.

As per claim 13, Kamakura does not expressly disclose a merchant or advertiser having a plurality of locations wherein each location has a unique identifier or code.

However, having a merchant or grocer or a retailer or a Supermarket established a plurality of local stores located in different geographic locations wherein each local store has a unique address or a unique identifier uniquely identifying each local store in the merchant's database is an old and well taught in the art. Giant Food, INC., Red Apple, Shoppers, etc., commonly referred to as store chain, are examples of merchants with multiple local stores situated in different geographic locations. No further disclosure is necessary here ("Official Notice").

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention, without reading the Instant Application, to incorporate the above disclosure ("Official Notice") into the e-mail communication of Kamakura so as to send or transmit by a processing facility or clearinghouse an e-mail message, having printed therein an advertising message from a merchant promoting a product or service available at a local store located in a specific geographic location, to a registered recipient or patron living in a geographic location adjacent to

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the local store, thereby rendering the e-mail communication more appealing to the recipient by presenting location-sensitive advertising message to the customer or recipient and encouraging the recipient to read or view the merchant's message and eventually purchase the product or service, by using a certain number of accumulated bonus points redeemable on the product or service, featured in the message and sold at a nearby local store, while providing great flexibility and ability to the merchant to effectively advertise the product or service availability at a particular destination or geographical location, outside the merchant's usual target market, and enabling the advertiser or merchant to target an e-mail recipient based on his geographic location adjacent to a local store or based upon a geographical location of interest to the advertiser or merchant, which in the end increases market share for the product or service at the geographic location of interest.

As per claim 17, although Kamakura discloses a system wherein a notification e-mail message is sent to a registered patron when his total accumulated bonus points reach a preset threshold number so that the recipient can redeem these points for a gift (col. 9: 10-18; col. 9: 33-53), Kamakura does not explicitly teach where the gift is sold, nor does he mention a merchant unit having at least one redemption button displayed thereon, reflecting a redemption offer associated with a responding recipient.

However, using a unit having a reward or redemption button incorporated thereon is old and well established in the art. For example, a customer, member of a reward program, conducting a fuel transaction presses a "reward button" in the interface of the fuel dispenser, the gas station system will automatically dispense fuel for the customer at a discounted price,

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subsequent to identifying the customer and in accordance with the customer's reward information stored in a remote database ("Official Notice").

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention, without reading the Instant Application, to incorporate the above disclosure ("Official Notice") into the e-mail communication of Kamakura so as to send or transmit by a processing facility or clearinghouse an e-mail message, having printed therein an advertising message from a merchant along with a hyperlink representative of the merchant's web site address having displayed thereon a reward or redemption button, to a registered recipient or patron and wherein, upon clicking on the hyperlink displayed in the e-mail message, the recipient is transported to the merchant's or advertiser's web site, having printed thereon a redemption button associated with the identified recipient, where the recipient can receive more detailed information about a product or service featured in the advertising message or even purchase the said product or service or other products or services, upon redeeming certain number of accumulated bonus points, and the recipient further earns award bonus points for reading or responding to the e-mail and visiting the merchant's web site, where he can redeem some of his accumulated points, and wherein data regarding the transaction or the purchase are stored at the advertiser's system or web server where they are being utilized in further marketing analysis or to further target the customer and to compile accounting report used to compensate the processing facility or clearinghouse for successfully referring customers to the advertiser's or merchant's web site, thereby encouraging a patron or recipient who reads a merchant's advertising message to immediately provide feedback to the merchant or advertiser or sender of the targeted e-mail and further earn award bonus points when the patron clicks on a hyperlink within the e-mail to visit

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the merchant's or advertiser's web site to receive more information about a product or service featured in the e-mail or even purchase the said product or service or other products or services sold at the merchant's web site, by redeeming some of his accumulated points, and wherein data regarding the transaction or the purchase are stored at the advertiser's or merchant's system or web server where they are being utilized in further marketing analysis or to further target the customer and to compile accounting report used to compensate the processing facility or clearinghouse for successfully referring customers to the advertiser's or merchant's web site, while rendering the system more cost-effective and enabling the merchant to measure the effectiveness of the distribution medium or processing facility in real-time.

### **Response To Applicant's Arguments**

First of all, the arguments as presented here are related to the newly added claim limitations and are fully addressed in the above Office Action.

Second of all, and in general, it appears that the Applicant is still arguing that the Kamakura's reference does not teach a merchant associated with an e-mail communication. Once again, as the Examiner demonstrated during the interview, Kamakura explicitly discloses a sender or advertiser or company (or a merchant) preparing a promotional e-mail and forwards it to a processing facility or clearinghouse, which distributes the said e-mail to a set of qualified users or recipients, who receive bonus points for reading or replying to the e-mail and wherein the recipients can redeem the accumulated bonus points for free gifts or products sold by the e-mail sender or merchant or company (See abstract; col. 4 : 38 - 51).

Third of all, regarding the 103 Rejection, it appears that the Applicant disagrees with the Examiner's taking of "Official Notice" for certain aspects of the claimed invention. However,

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the Applicant fails to explicitly point out the deficiencies in the "Official Notice". In other words, the Applicant fails to demonstrate whether or not the Examiner's assertion are factually inaccurate based on printed documents supplied by the Applicant or based on the Applicant's own background in the art. The fact that a printed material is not readily available during examination of an Application does not necessarily imply that the subject matter is patentable. **Further, features that are well known in the art or widely used in the industry need not be disclosed in a reference in order for these features to be rendered obvious during an examination. Moreover, failure of those skilled in the art to contemporaneously recognize a well known property function or ingredient in the prior art does not preclude a finding of well established or well taught material or publicly disclosed material.** Hence, Applicant's request for a reference is improper and will not be honored.

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not plausible and thus, the last Office Action, as shown below, is hereby maintained and the current **Office Action has been made Final.**

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 5, 793, 972A to Shane discloses a system for sending an e-mail message, having printed therein a hyperlink, to a registered recipient and wherein upon activating the



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hyperlink the recipient can visit his personal web page where he can view customized or personalized promotional messages directed to his attention.

WO 97/23838 to Scroggie teaches an incentive distribution network or system over the Internet wherein a plurality of purchasing incentives and shopping aids are made available for qualified customers through the Internet or via e-mail. A customer (10) of retail stores, logs into the system and then elects to browse among available purchasing offers (18, 22), elects to claim a product rebate or to receive product information. The system merges customer's supplied information (270) with other purchase incentive data (272) and creates a printable graphical image of the purchasing incentive (282) for transmission to the customer. In an alternate embodiment, the purchase incentive is not transmitted directly to the customer. Instead, the terms of the incentive are transmitted electronically to the retail store (310) of fig. 13 designated by customer (10) or located in the customer's geographical region, who receives either a token (316) having at least a specific code or a bar code to present at the store or an advisory message used along with other identification to identity the customer at the POS during a redemption process. Further, in yet another embodiment, incentives may be targeted to specific customers based on a customer's purchase history (502) and transmitted to the consumers by e-mail using the customers' e-mail addresses stored in a consumer database (506). In other words, notification or indication of the availability of these incentives is transmitted to the customers in the form of Internet messages, for retrieval when the customers or consumers next access a web site associated with the system or check their e-mails. Finally, the incentive message informs a customer that one or more specific offers are available and can be received at a participating POS when the prerequisite products are purchased. Alternatively, subsequent to receiving an e-mail

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notification or an indication of an incentive offer, an image of a paper coupon may be transmitted to the customer's computer site and printed for later presentation at pre-selected POS (See abstract; page 9: 22-30; page 12: 23-25; page 13: 2-3; page 15: line 3-10; page 20: 2-8; page 20:16 to page 21: 30; figs 9 and 11-15). **Finally, Scroggie discloses a system for collecting registration information from a user via a web site, wherein the user can select coupons off a web page, subsequent to determining that the user lives in a particular zip code, and wherein the coupons can be e-mailed to the user (figs. 1-9).**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner

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by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113.

Further, the following fax numbers can be used, if need be, by the Applicant(s):

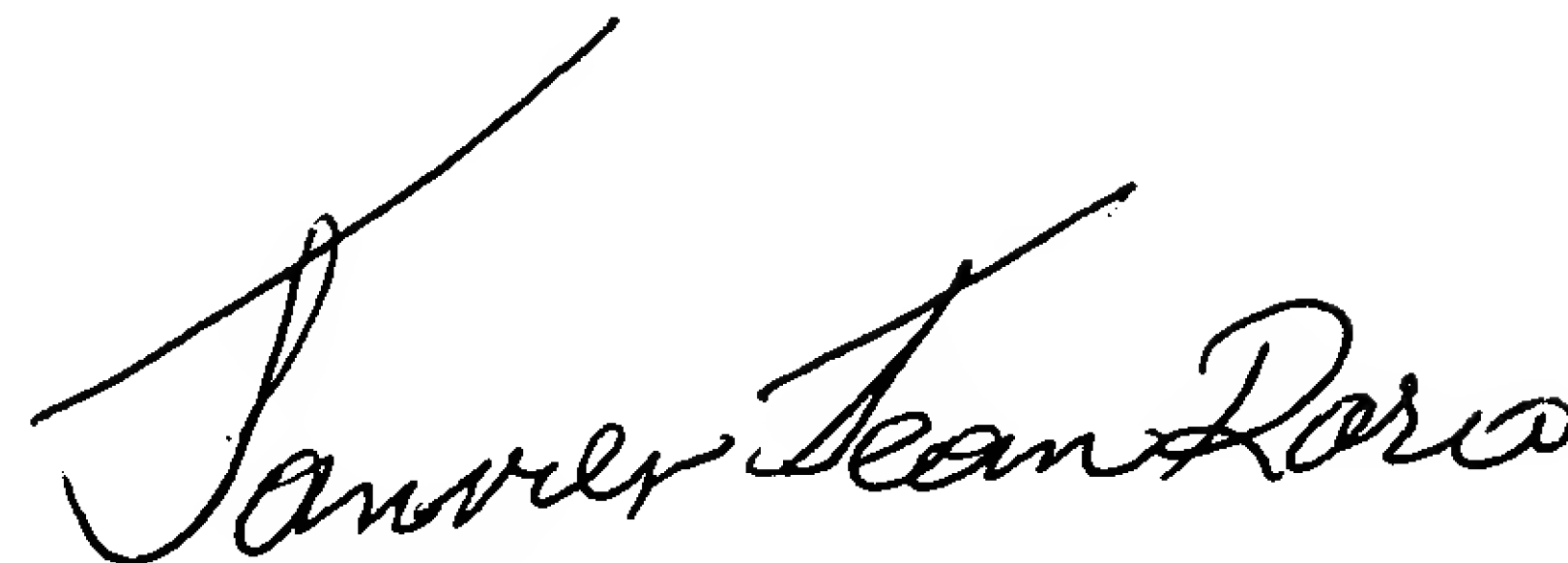
After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ  
08/11/04



Jean D. Janvier  
Patent Examiner  
Art Unit 3622